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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,236	09/17/2003	Sandra M. Maclean	11842/US/2	5239
25763 7590 03/17/2008 DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 1500 50 SOUTH SIXTH STREET MINNEAPOLIS, MN 55402-1498				
			EXAMINER ANDERSON, CATHARINE L	
			ART UNIT 3761	PAPER NUMBER
			MAIL DATE 03/17/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/664,236

Applicant(s)

MACLEAN ET AL.

Examiner

Lynne Anderson

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 10-31, 33 and 35 is/are pending in the application.
- 4a) Of the above claim(s) 10-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 25-31, 33 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7 January 2008 has been entered.

Response to Amendment

2. The Declaration under 37 CFR 1.132 filed 7 January 2008 is insufficient to overcome the rejection of claims 1 and 25-30 based upon Schumacher (4,917,238) as set forth in the last Office action because: The expert opinion given in the Declaration, such as the average amount of fetal remains expelled during a miscarriage, is not supported by any documentary evidence. Further, there is no nexus between the invention as claimed and the evidence laid out in the Declaration. The present claims do not disclose features, such as the amount of fetal remains to be collected or the placement of the specimen pan in a toilet, upon which the arguments in the Declaration are based. Therefore, the Declaration is insufficient to overcome the present rejections.

3. The amendment filed 7 January 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The underpad

having a bottom surface that is impermeable to bodily fluids is not supported by the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

4. Applicant's arguments filed 7 January 2008 have been fully considered but they are not persuasive.
5. In response to applicant's argument that Schumacher fails to disclose collection of fetal remains, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.
6. In response to applicant's argument that Schumacher fails to disclose a pad having a bottom surface that is impermeable to bodily fluids, it is noted that this limitation is not supported by the specification, and therefore considered new matter.

Specification

7. The amendment filed 7 January 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The underpad having a bottom surface that is impermeable to bodily fluids is not supported by the originally filed specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1, 26-31, 33, and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The underpad having a bottom surface that is impermeable to bodily fluids is not supported by the specification. The present specification discloses on page 9, lines 10-11 that the underpad has a backing on the bottom surface comprising polypropylene. Polypropylene can be used to manufacture a variety of materials, such as films and nonwoven fabrics. Polypropylene materials such as nonwoven fabrics are not inherently liquid impermeable, and are often permeable to liquids. Therefore, the claim limitation disclosing a liquid impermeable bottom surface is not supported by the specification as originally filed, and constitutes new matter.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 25-31, and 33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schumacher (4,917,238).

12. With respect to claims 1, 31, and 33, assuming the limitation "miscarriage" is given little patentable weight, Schumacher discloses a kit 10 for cleaning up body waste such as vomit, blood, feces and the like (column 1, lines 9-12; column 2, lines 6-7; figure 1) comprising a pad 52 having an absorbent surface (column 2, lines 45-47); a disposable absorbent towel 50 and sanitary napkin 51 (column 2, lines 45-47); disposable plastic gloves 57, 58 (column 2, lines 52-53); scoop/specimen pan 80; and container 64. The specimen pan 80 is fully capable of receiving human tissue, and the container 64 is fully capable of holding fetal remains.

13. Alternatively, assuming the limitation "miscarriage kit" is given patentable weight and is consistent with its plain ordinary meaning of expulsion of a fetus from the womb before it is able to survive independently (see Oxford online dictionary), regarding claim 1 Schumacher discloses a waste cleanup kit 10 for cleaning up body waste such as vomit, blood, feces and the like (column 1, lines 9-12; column 2, lines 6-7; figure 1) that is thus capable of being used as a miscarriage kit since the elements of the kit are fully capable of being used to clean up after a miscarriage.

14. With respect to claim 25, the container 64 is spill-proof and sanitary since it has a cap 68 that confines the liquids (column 3, line 20).

15. With respect to claims 26-30, the kit further comprises label/list 63 (column 2, lines 64-68); two plastic bags 53, 54 (column 4, lines 47-48); germicidal hand wipe 7; and scraper 90 (column 3, lines 25 and 33-34).

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schumacher (4,917,238) in view of Gordon (6,434,762).

18. Schumacher discloses a kit with a specimen pan 80 as disclosed above with respect to claim 1. Schumacher *does not expressly disclose* the pan is configured to fit inside the rim of a toilet. Gordon discloses a stool/waste collecting apparatus 10 secured to a toilet seat (column 2, lines 28-31) and having a receptacle/specimen pan 14 which fits inside the rim of a toilet (column 2, lines 46-55; figures 1-3) for depositing bodily waste without fear of touching the sample (column 3, lines 31-41). One would be motivated to modify the kit of Schumacher with the specimen pad of Gordon to improve the anti-contamination of the system since both references disclose apparatus to dispose of bodily waste. Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to modify the kit, thus providing a specimen pan to fit inside a toilet rim.

19. With respect to the container being opaque, Schumacher further discloses a container 12, as shown in figure 2, formed from cardboard, as described in column 2, lines 8-9. Cardboard is an opaque material, and therefore Schumacher discloses a container that is opaque.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynne Anderson whose telephone number is (571)272-4932. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

cla
/L. A./
Examiner, Art Unit 3761
/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761